



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Applicants: Peter S. Linsley et al.
Serial No.: 09/609,915
Filed: July 3, 2000
Docket: 30436.30USI2
Title: SOLUBLE CTLA4 MUTANT MOLECULES AND USES THEREOF

CERTIFICATE UNDER 37 CFR 1.8

I hereby certify that this paper or fee is being deposited with the United States Postal Service as first class mail in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231 on November 4, 2002.

By: 
Name: Tracy R. Truick

55 S. Lake Avenue, Suite 710
Pasadena, California 91101
November 4, 2002

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

We are transmitting herewith the attached:

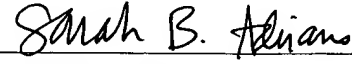
- ☒ Transmittal sheet, in duplicate, containing Certificate under 37 CFR §1.8
- ☒ Amendment in Response to the October 2, 2002 Office Action
 - ☒ No Additional fee is required
 - ☐ The fee has been calculated as shown below in the "Claims as Amended" table
- ☒ Return postcard

CLAIMS AS AMENDED

Claims Remaining After Amendment		Highest Number Previously Paid For		Present Extra		Rate		Fee
Total Claims								
24	-	24	=	0	x	.00	=	\$0.00
Independent Claims								
3	-	3	=	0	x	.00	=	\$0.00
MULTIPLE DEPENDENT CLAIM FEE								\$0.00
TOTAL FILING FEE								\$0.00

Please charge any additional fees or credit overpayment to Deposit Account No. 50-0306. A duplicate of this sheet is enclosed.

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Dkt. 30436.30USI2 SBA/RDG

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Peter S. Linsley, et al.
Serial No. : 09/609,915 Examiner: E. M. Lazar-Wesley, Ph.D.
Filed : July 3, 2000 Group Art Unit: 1646
For : SOLUBLE CTLA4 MUTANT MOLECULES AND USES
THEREOF

55 South Lake Ave., Suite 710
Pasadena, California 91101
November 4, 2002

Assistant Commissioner for Patents
Washington, D.C. 20231

Madam/Sir:

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**AMENDMENT IN RESPONSE
TO THE OCTOBER 2, 2002 OFFICE ACTION**

This Amendment is submitted in response to the Office Action dated October 2, 2002, issued by the U.S. Patent and Trademark office in connection with the above-identified patent application. A response to the Office Action was due November 2, 2002. However, since November 2, fell on a Saturday, a response filed the next business day, namely Monday, November 4, 2002, will be considered timely. Accordingly, this Amendment is being timely filed.

RESTRICTION REQUIREMENT

In the Office Action, the Patent Office is requiring restriction under 35 U.S.C. §121 to one of the following Groups of inventions:

- Group I: Claims 1-9 and 11-18 are directed to soluble CTLA4 mutant molecules, soluble CTLA4 mutant fusion molecules, nucleic acid molecules encoding the soluble CTLA4 mutant molecules, and methods for producing the soluble CTLA4 mutant molecules;
- Group II: Claims 19-22 are directed to methods for regulating a T cell interaction with a CD80 and/or CD86 positive cell; and
- Group III: Claims 23-25 are directed to methods for treating immunoproliferative diseases.

TRAVERSAL

Applicants hereby confirm election of the invention of Group I with traverse.

Reconsideration of the Restriction Requirement is requested for the following reasons:

Applicants point out that under MPEP §803, there are two criteria for a proper requirement for restriction, namely: (1) the invention must be independent and distinct; AND (2) there must be serious burden on the Examiner for restriction to be required.

Applicants respectfully contend that the first requirement of §803 has not been met, since the claims of Groups II and III depend, directly or indirectly, upon the claims of Group I. Specifically, Applicants contend that the methods for regulating T cell interaction recited in Group II are not independent of the molecules of Group I since the methods of Group II require administration of the soluble CTLA mutant molecules of Group I. Applicants also contend that the methods for treating immunoproliferative diseases recited in Group

III are not independent of the molecules of Group I since the methods of Group III require administration of the soluble CTLA mutant molecules of Group I.

Therefore, the invention in Groups I, and II and III, are not independent and distinct. Accordingly, the criteria for requiring the restriction has not been met.

Applicants respectfully contend that the second requirement of §803 has also not been met. The Patent Office has not demonstrated a serious burden for searching the art of Groups I-III. Each of the claims of Groups I and II are classified in the same class. Therefore, the art with respect to the claims in Groups I and II overlap. The Examiner can perform a search on the entire application without serious burden. Thus, search of the art with regard to the invention of Groups I and II would not place an undue burden on the Examiner. Moreover, separate prosecution of these claims would be unnecessarily duplicative and thus wasteful of Patent Office resources. Therefore, under MPEP Section 803, the instant claims do not require restriction.

Applicants submit that claims of Groups I, II and III should properly be examined together for the reasons discussed above. Applicants respectfully request that the Examiner reconsider and withdraw the Restriction Requirement as these claims.

Conclusion

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone her at the number provided below.

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No fee is deemed necessary in connection with the filing of this Amendment. If any fee is necessary, the Patent Office is authorized to charge any additional fee to Deposit Account No. 50-0306.

Respectfully submitted,

Sarah B. Adriano

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